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In re application of

Fabrice Diehl et al.

Serial No. 10/612,288

Filed: July 3, 2003

For: HYDROTREATING CATALYST THAT CONTAINS A NITROGEN-CONTAINING  
ORGANIC COMPOUND AND ITS USE

DECISION ON  
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY  
OF THE OFFICE ACTION mailed March 18, 2005.

On October 5, 2004, a first office action was mailed to applicants, containing various grounds of rejection. It is noted that claim 5 was not rejected over any prior art. Applicants responded to this office action with a response filed on January 5, 2005. Claim 5 was not substantially amended, other than to change the dependency to claim 1. A final rejection was then mailed March 18, 2005.

On March 30, 2005, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the March 18, 2005 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection applied in the final office action were not necessitated by Applicant's amendments to the claims.

## DECISION

Section 706.07(a) of the MPEP states:

### 706.07(a) Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)..

Petitioner argues that because claim 5 was not rejected over any prior art in the non-final office action of October 5, 2004, and then rejected for the first time in the final office action, the new grounds of rejection were not necessitated by Applicant's amendments to the claims. This argument is persuasive. Therefore, the new ground of rejection over claim 5 was not necessitated by Applicant's amendment.

Because the rejection of claim 5 over newly cited prior art was not necessitated by Applicant's amendments to the claims, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also noted that Applicants filed a response to the March 18, 2005 office action on June 7, 2005. This amendment will be treated as an amendment after non-final office action and will be entered. The application is being forwarded to the examiner to consider the amendment and prepare an appropriate office action.

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